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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,098	12/14/2004	Michael Hartung	PAT-00391	5412

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BASF CORPORATION
Patent Department
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EXAMINER

MAYEKAR, KISHOR

ART UNIT	PAPER NUMBER
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1795

NOTIFICATION DATE	DELIVERY MODE
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12/19/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/518,098	Applicant(s) HARTUNG ET AL.	
	Examiner Kishor Mayekar	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. Claims 1-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Klein (US 5,965,000) in light of or in view of Ikenoue et al. (US 6,730,203 B2), for reasons as of record.

2. Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein '000 in light of or in view of Ikenoue '203. Klein in light or in view Ikenoue is applied above. Klein further discloses that the electrocoat concentrate has a solids content of between 35 and 50 wt% (c. 2, l. 38-51), a finished electrocoat has a solids content of 20 wt% (Example 3), and bismuth salicylate is one of the examples of the bismuth compound used with a concentration of 0.5 to 5 wt% (c. 6, l. 41-43). To the recited solids content of the composition, whether concentrate or finished composition, and the concentration of the bismuth compound, a prima facie case of obviousness exists where the prior art contain numerical ranges of components that touch, overlap, or are included within one another, *In re Wertheim* 191 USPQ 90.

Further, since bismuth salicylate and bismuth subsalicylate are a same compound, the recited bismuth content range is in Klein's bismuth salicylate.

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As to the subject matter of claim 17, since the claim is directed to a composition, the sequence of adding ingredients was held to be obvious (see MPEP 2144.IV.C). Further, Klein discloses the incorporation of bismuth compound in pigment pastes (c. 7, l. 1-4).

As to the subject matter of claims 19 and 20, Klein discloses a grinding resin in Example 3.b).

Double Patenting

3. Claims 1-15 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 7-14, 16 and 18 of copending Application No. 11/416,909, for reasons as of record.

Response to Arguments

4. Applicant's arguments filed 25 September 2008 have been fully considered but they are not persuasive.

In response to Applicant's argument that "Klein actually uses, in all the examples of an electrocoat composition, a bismuth salt of an aliphatic carboxylic acid, ... bears no predictable or obvious relationship to bismuth subsalicylate", since Klein discloses in c. 6, l. 25-55 that bismuth compound is aromatic, araliphatic and aliphatic mono- or dicarboxylic acids and examples of the bismuth compound includes bismuth salicylate, bismuth 4-hydroxybenzoate, bismuth lactate, bismuth dimethylolpropionate, and uses bismuth dimethylolpropionate in Example 3, one of the four examples of bismuth compounds

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disclosed, the selection of bismuth compounds among the four examples of bismuth compounds would have been within the level of ordinary skill in the art. Further, bismuth salicylate is also known as bismuth subsalicylate according to Material Safety Data Sheet of bismuth salicylate from Gelest, Inc.

As the argument that Klein does not mention of bismuth subsalicylate, since Klein discloses bismuth salicylate as one of the four bismuth salts and since bismuth salicylate is known as bismuth subsalicylate, it's the examiner position to maintain the rejection.

As to the argument that Klein discloses that bismuth salts of aliphatic hydroxycarboxylic acids are particularly suitable and that bismuth salts are particularly preferably water-soluble and does not mention the possible adverse affects of a bismuth salt on leveling and surface defects in the coating, the examiner finds this is unpersuasive. Since Klein discloses the use of bismuth salicylate as one of the four bismuth compounds in the composition and the bismuth compound is water-soluble or dispersed in the composition and since bismuth salicylate is also known as bismuth subsalicylate, the rejection stands.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kishor Mayekar whose telephone number is (571) 272-1339. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on

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access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kishor Mayekar/
Primary Examiner, Art Unit 1795